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EXAMINER

SAYADIAN, H

22M2/1007

ART UNIT PAPER NUMBER

8

HECKER AND HARRIMAN  
SUITE 1600  
2029 CENTURY PARK EAST  
LOS ANGELES CA 90067

2202

DATE MAILED:

10/07/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on \_\_\_\_\_  This action is made final.

A shortened statutory period for response to this action is set to expire three month(s), now days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.  
3.  Notice of Art Cited by Applicant, PTO-1449.  
5.  Information on How to Effect Drawing Changes, PTO-1474.
2.  Notice of Draftsman's Patent Drawing Review, PTO-948.  
4.  Notice of Informal Patent Application, PTO-152.  
6.  \_\_\_\_\_

Part II SUMMARY OF ACTION

1.  Claims 1 - 22 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1 - 22 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).

12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

*additional drawings are required. See first action*

EXAMINER'S ACTION

## **OBJECTIONS/REJECTIONS NOT BASED ON PRIOR ART**

### ***DISCLOSURE: Generally***

1. This disclosure--including disclosed specification, drawings, *and* claims--is replete with grammatical, style, punctuation, and typographical errors too numerous to mention *all* specifically.

Applicants must correct all errors in the application, *whether or not specifically mentioned in this office action*.

The corrections, of course, may not introduce new matter.

### ***DISCLOSURE: Drawings***

2. This application has been filed with informal drawings, which are acceptable for examination purposes only. Draftsperson has not reviewed the drawings because they were declared informal by Applicants. Formal drawings will be required when the application is allowed.
3. The subject matter of this application, specifically claims 1-22 admit of illustration by drawings to facilitate understanding of the invention. Applicants are required to furnish drawings under 37 C.F.R. § 1.81.

At the very least, Applicants *must* submit a drawing showing all of the steps of claims 1 and 12.

### ***DISCLOSURE: Abstract***

4. The Abstract of the Disclosure is objected to because it does not present that which is new in the art to which the invention of this application pertains. See M.P.E.P. § 608.01(b).

*Correction is required.*

5. Applicants are reminded of the proper content and form of an Abstract of the Disclosure. See M.P.E.P. § 608.01(b).

A patent abstract assists a reader in quickly, yet accurately, deciding whether to consult the full patent text for details. To achieve this objective, the abstract should enable

the reader, regardless of the reader's degree of familiarity with patent documents, quickly to ascertain the character of the subject matter covered by the technical disclosure.

*Therefore*, an abstract must be a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

*Moreover*, the abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

*Furthermore*, the abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 250 words. The abstract should neither exceed 25 lines of text, nor exceed 250 words in length.

The abstract should sufficiently describe the disclosure to assist readers in deciding whether there is a need for consulting the full patent text for details. *Therefore*:

- i. The language should be clear and concise and should not repeat information given in the title.
- ii. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.
- iii. Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be given.
- iv. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.
- v. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.
- vi. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof.

- vii. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

***DISCLOSURE: Specification***

6. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or to use the invention, i.e., failing to provide an enabling disclosure. The detailed description does not enable one of reasonable skill to make or practice, or both, the invention of claims 11 and 122.

***DISCLOSURE: Claims***

8. The ordering of the claims is objected to as containing intervening claims between claims and the claims that depend therefrom. This is not in accordance with 37 C.F.R. § 1.75 (g), which states: "(g) All dependent claims should be grouped together with the claim or claims to which they refer to the extent possible."

The claims should be renumbered to conform with 37 C.F.R. § 1.75 (g). Correction is required.

9. Claims 11 and 22 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. See supra, ¶ 7, 35 U.S.C. § 112, first paragraph, objection to the disclosed specification.

10. Claims 1-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard as the invention.

In addition to the ambiguities specified below, the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from the foreign document and are replete with grammatical and idiomatic errors.

With respect to claims 1-22:

Although these claims are supposed to be defining a method invention, there does not seem to be any recited steps. On the other hand, the recitations do not seem to define structures either. This ambiguity renders indefinite scope of claims 1-11.

With respect to claims 2 and 13:

It is unclear what "a digital signature is *given* to said digital data" means.

With respect to claims 3 and 14:

It is unclear what "controlling copyright" means. Moreover, it is unclear what "copyright information for copyright" means.

With respect to claim 18:

It is unclear what "encryption of said digital data is decrypted by said ..." means.

## **REJECTIONS BASED ON PRIOR ART**

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the bases for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled

the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(f) he did not himself invent the subject matter sought to be patented.

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

12. The following is a quotation of 35 U.S.C. § 103 that forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

13. Examiner has broadly read the claims, which broad reading is concomitant with the ambiguities of claims 1-22, which ambiguities necessitated the 112(2) rejections.
14. Claims 1-22 are rejected under 35 U.S.C. § 102(e) as being anticipated by reference any of Dolphin, Fahn et al. [hereinafter Fahn], Okano, or Matsumoto et al. [hereinafter Matsumoto].

15. Claims 2-11 are rejected under 35 U.S.C. § 103 as being unpatentable over any of Dolphin, Fahn, Okano, or Matsumoto, as applied to claim 1 and 12, and further in view of what is well known.

The deficiencies of the cited prior art, if any, with respect to the dependent claims 2-11 deal with features that are well known and commonly used in the art. Such features would, therefore, have been obvious to incorporate in the cited prior art.

16. Claims 12-22 are rejected under 35 U.S.C. § 103 as being unpatentable over Okano or Matsumoto further in view of Gasser et al. [hereinafter Gasser].

Gasser teaches transmitting a decryption key to authenticated entities authorized to access the data. To limit access to antedates the data base authenticates as authorized, it would have been obvious to incorporate the teachings of Gasser in the teachings of Okano or Matsumoto.

The deficiencies of the cited prior art, if any, with respect to the dependent claims 13-22 deal with features that are well known and commonly used in the art. Such features would, therefore, have been obvious to incorporate in the cited prior art.

## **REJECTIONS BASED ON DOUBLE PATENTING**

17. Claims 1-22 are directed to an invention not patentably distinct from claims 1-26 of commonly assigned U.S. Patent Application S/N 08/549,271. Specifically, claims 1-26 in said Application recite the same limitations as in this Application.

18. Commonly assigned U.S. Patent Application No., discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

19. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending application Serial No. 08/549,271. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims of said U.S. Application recite the same limitations of the invention in this application.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

21. Claims 2-11 and 13-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending application Serial No. 08/549,271 in view of what is well known.

The deficiencies of said U.S. Application, if any, with respect to the dependent claims 2-11 and 13-22 deal with features that are well known and commonly used in the art.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

## INFORMATION ON HOW TO CONTACT THE USPTO

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hrayr A. Sayadian whose telephone number is (703) 306-4169. The examiner can normally be reached on Monday through Friday, from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza, can be reached on (703) 306-4171. The fax phone number for this Group is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-4177.

Hrayr A. Sayadian  
9-27-1996

*Thomas Tarcza*  
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